

REMARKS/ARGUMENTS

The amendments set forth above and the following remarks are responsive to the points raised by the Office Action dated September 8, 2008. In view of the amendments set forth above and the following remarks, reconsideration is respectfully requested.

The Pending Claims

Claims 1-14 are pending. Claim 14 is added. Support for claim 14 may be found within the original specification, claims, and drawings. No new matter is added. Support for claim 14 may be found in the specification at, e.g., page 2, lines 4-6.

Request for Interview

Applicant requests a personal interview between his representative and the Examiner before examination on the merits of the claims, pursuant to MPEP 706.07(b), to display and demonstrate an example of a notebook according to Herlitz.

The Office Action

Claims 1-13 were rejected under 35 U.S.C. § 103 as unpatentable over DE 200707028 to Herlitz (hereinafter, "Herlitz") in view of FR 2,792,573 to Gallot (hereinafter, "Gallot").

This rejection is separately and respectfully traversed.

Herlitz describes a document filing folder 10. As shown in Figures 1 and 2 of Herlitz, that folder includes a cover 20 and an anterior sheet 31, located on the left of a spiral binding 18a, and a posterior sheet 120 located on the right of the spiral binding. The spiral binding joins the anterior and posterior sheets. In addition, sheets 11, such as drawing sheets, are bound to the spiral binding 18a.

One of the cover sheets, namely cover sheet 31, includes a first flap 33 along one of the lower and upper edges of the sheet and the second flap 32 along a lateral edge of that sheet 31. The two flaps 32 and 33 are folded towards an interior side of the sheet 31 to form a pocket 15 for storing and accessing individual sheets that have been previously separated

from the binding 18a, for example, by tearing along the perforations 18 shown in Figure 1 of Herlitz.

In Herlitz, the two flaps 32 and 33 have overlapping ends 32a and 33a (last two lines of page 5 through the first four lines of page 6; Figure 2). The two flaps overlap in an area 35 and are permanently attached to each other by an adhesive covering at least part of the area 35.

Because of the structure of the Herlitz folder, the two flaps 32 and 33 forming the pocket 15 are *permanently* folded toward the anterior side of the cover 31. In other words, the flaps cannot be unfolded for the insertion of papers.

When the folder of Herlitz is closed as shown in Figure 1, any sheets stored within the pocket 15 are prevented from sliding movement (page 6, lines 6-15). Therefore, if an attempt were made to insert in the pocket sheets that were still attached to the binding, when the folder is closed, the sheets would be wrinkled. When the Herlitz folder 10 is opened, of course, sheets that have been previously separated from the binding can be inserted in the pocket 15 as indicated by arrows in Figure 2 of Herlitz. Herlitz fails to teach or suggest inserting in the pocket sheets still attached to the binding. Even if the still-attached sheets could be fitted at all in the pocket 15, the sheets would become wrinkled.

The Office Action correctly acknowledges that Herlitz does not disclose that the flaps 32, 33 are foldable from an open position to a closed position where in the open position the notebook pages are fully accessible. Moreover, Herlitz also fails to disclose inserting sheets still attached to the binding 18a into the pocket 15.

For the reasons set forth above, claims 1, 12, and 13 are distinguishable from Herlitz. Claim 13 is further distinguishable from Herlitz in that a second portion of the notebook pages is positioned above the first and second flaps under which the first portion of notebook pages is stored, so that the two flaps advantageously form an indexing mechanism.

Gallot discloses a document filing folder comprising a cover including an interior sheet 2 and a posterior sheet 1, wherein the posterior sheet 1 includes at least a first flap 16, 17 along one of the lower and upper edges of the first sheet 1, and a second flap 10 along the lateral edge of the first sheet 1. The first and second flaps can have a first position folded one

on top of the other towards an interior side of the first sheet 1 to form a pocket wherein separated sheets D can be stored. The first and second flaps can have a second position folded away from the interior side of the first sheet 1, wherein the notebook pages D stored under the first and second flaps are fully accessible from the first and second flaps both in the second position.

According to the Office Action, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the flaps of Gallot in place of Herlitz's flaps since flaps can either be provided in a fastened position with one another or a non-fastened position.

The Applicant respectfully submits that the Office Action has not set forth a *prima facie* case for obviousness as set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). As set forth in *Graham*, obviousness is evaluated based on (A) ascertaining the differences between the claimed invention and the prior art; and (B) ascertaining the differences between the claimed invention and the prior art; and (C) resolving the level of ordinary skill in the pertinent art. Moreover, a finding of obviousness must be supported by an explanation as to why the differences between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. *Innogenetics N.V. v. Abbott Laboratories*, 85 U.S.P.Q.2d 1641, 1648 (Fed. Cir. 2008). A mere statement that the reference *can* be modified as stated in the Office Action is insufficient to support a finding of obviousness.

Furthermore, in a proper obviousness determination, the prior art must be viewed from the point in time just prior to when the claimed device was made. As stated in *In re Sporck*, 301 F.2d 686, 689, 133 USPQ 360, 362-63 (C.C.P.A. 1962), a proper obviousness evaluation must "view the prior art without reading into that art the teachings of appellant's invention." Contrarily, the Office Action's position is premised on impermissible hindsight reasoning.

The Office Action's statement that "the flaps are capable of retaining pages which are bound by the spiral since section 35 of the flaps are glued to one another and therefore allow flexing for insertion of pages," is a result of reading into Herlitz the teaching of the claimed invention. The Office Action has not explained why one of ordinary skill in the art would

modify Herlitz to store pages which are bound by the spiral 18a in the pocket 15 since Herlitz only teaches a document filing folder wherein the two flaps 32, 33 are fastened to one another by gluing to define the pocket 15 and that only separated sheets are stored in the pocket. One of ordinary skill in the art reading Herlitz at the time the invention was made would recognize that the intention of Herlitz was to provide the two flaps 32, 33 fastened with one another to form the pocket 15 intended to store only separate sheets.

The problem to be solved by the invention is to provide a document filing folder wherein notebook pages attached to the binding can be stored in an ordered manner, without losing the notebook pages, and without damaging or wrinkling the pages during their introduction into the storing space. To solve this problem, the document filing folder of the invention includes the technical features recited in claims 1, and 12-13.

In the solution taught by Herlitz, however, only separate notebook pages are stored in the pocket 15 defined by the two flaps 32, 33 fastened to one another by gluing in a position folded against the corresponding sheet 31 of the document filing folder 10. The solution set out in Herlitz does not solve the technical problem solved by the claimed invention because in Herlitz, the notebook pages stored in the pocket 15 can escape by sliding from the pocket when the filing folder 10 is closed in the upward direction with regard to Figure 2 of Herlitz in and, in particular, when the folder is carried by a user in an inverted position with respect to Figure 1 of Herlitz. Moreover, the separate notebook pages are stored in a disordered manner in the pocket 15, which can store only a small quantity of notebook pages since the two flaps 32, 33 are fastened with one another in the overlapping area 35.

With respect to Gallot, the applicant is of the opinion that it was not obvious to a person of ordinary skill in the art to combine the teaching of Gallot with Herlitz's folder. Indeed, as already explained, Herlitz does not disclose anything other than a document filing folder wherein the two flaps 32, 33 are fastened with one another by gluing in the overlapping region 35 to define the pocket 15. In Gallot, the flaps 10, 16, 17 of the document filing folder are freely hinged to the corresponding edges of the sheet 1 so that the flaps can be folded and unfolded for storing separate notebook pages and accessing the notebook pages, respectively.

In Herlitz, the only intention is to provide the two flaps 32, 33 so that they are permanently fastened with one another through their overlapping area 35 to form a permanently closed pocket 15 to prevent the separated notebook pages from escaping the pocket 15 when the folder 10 is opened at the position shown in Figure 2. This is contrary to the folder of Gallot, wherein the separate notebook pages can slide with one another and relative to the flaps when the folder is opened at its position shown in Figure 1.

One of ordinary skill in the art would not have been motivated to combine Gallot's teaching with Herlitz's folder to provide a folder having the components claimed in claims 1 and 12-13. Therefore, the obviousness rejection of claims 1 and 12-13 cannot be maintained.

With respect to claim 13, it is further to be noted that neither Herlitz nor Gallot teach or suggest that the flaps provide an indexing means for two portions of the notebook pages securely connected to a binding, a first portion of the notebook pages being stored under the folded flaps and the second portion of notebook pages resting above the folded flaps. In contrast, in Herlitz, only individual and separated notebook pages are stored under the folded flaps 32, 33. In Gallot, only a stack of notebook pages is stored under the folded flaps, and one 12 of the flaps is provided with a tag 13 which is cut in the flap 12 and can be inserted within the stack of notebook pages stored under the flaps 12, 16, 17 of the folder. Providing an indexing system comprising first and second flaps, as claimed, is not taught in Gallot.

The Applicant further asserts that if one of ordinary skill in the art would attempt to read into Herlitz the teaching of the invention as alleged by the examiner, i.e., trying to insert notebook pages securely connected to the binder 18a into the folded position of the flaps 32, 33 fastened with one another, the notebook pages will be damaged by wrinkling because it would be necessary to flex the pages. Moreover, it would be impossible to insert in the pocket 15 defined by the flaps 32, 33 a stack of pages having a thickness larger than the space between the folded flaps and the internal face of the corresponding sheet 31. Indeed, the insertion of a stack of pages of a larger thickness would be blocked by the binder 18a on the one hand and the edge 33'b of the flap 33.

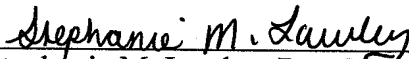
For the reasons set forth above, the obviousness rejection cannot be maintained.

Because the independent claims are allowable for the reasons set forth above, the dependent claims are also allowable because they depend from patentable independent claims. Claim 14 is also patentable, because none of the cited references teach or suggest a filing folder including the claimed indexing system including a third flap.

Conclusion

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,


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Amendment or ROA - Regular (SML/mlg)